



Patent  
Our Docket: 066654-585 (P-LJ 4377)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Rajotte et al.

Serial No: 09/676,475

Filed: September 29, 2000

For: METHODS OF IDENTIFYING  
LUNG HOMING MOLECULES  
USING MEMBRANE  
DIPEPTIDES

Commissioner for Patents  
Washington, D.C. 20231

Group Art Unit: 1631

Examiner: M. Moran

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is being deposited with the United States  
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envelope addressed to: Commissioner for  
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April 3, 2003.

By: Astrid R. Spain  
Astrid R. Spain, Reg. No. 47,956

April 3, 2003  
Date of Signature

RESPONSE TO OFFICE ACTION

Responsive to the Office Action mailed  
February 11, 2003, entry of the following Remarks is respectfully  
requested.

REMARKS

Claims 5 to 30 are pending.

Regarding the Restriction

The Examiner alleges that the claims are directed to  
two distinct and independent inventions as follows:

Group I: Claims 5 through 15, directed to a method of  
selectively directing a moiety to lung endothelium  
by administering a conjugate molecule comprising  
an MDP-binding molecule; and

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Group II: Claims 16 through 30, directed to a method of  
reducing or preventing lung metastasis.

Applicants respectfully remind the Examiner that two  
separate requirements must be met in order for restriction to be  
proper. First, the inventions must be independent or distinct.  
Secondly, there must be a serious burden on the Examiner if  
restriction is required. See, for example, MPEP 803  
(Restriction- When Proper), which states, in part:

If the search and examination of an entire  
application can be made without serious  
burden, the examiner must examine it on the  
merits, even though it includes claims to  
independent or distinct inventions.

Page 800-3; emphasis added.

Thus, it is not sufficient for an Examiner to assert  
that patentably distinct inventions are present in order to  
restrict an application. There also must be a serious burden on  
the Examiner to search and examine the restricted claims.

Applicants traverse on the ground that a search of  
Groups I and II together would not require an unduly extensive or  
burdensome search on the part of the Examiner. Applicants submit  
that, while the inventions of Groups I and II are patentably  
distinct, a thorough search of the methods of Group I likely will  
result in art relevant to the examination of the methods of Group  
II.

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Nevertheless, in order to be responsive to the requirement as required under 35 U.S.C. § 121, Applicants elect, with traverse, Group I, claims 5 through 15.

Regarding the Election

The Office Action further indicates that, if Applicants elect the claims of Group I, Applicants further are required to elect from the following species of MDP binding molecules:

- (a1) SEQ ID NO: 1, as set forth in claim 7; or
- (a2) SEQ ID NO: 2, as set forth in claim 7; wherein claim 6 is generic to claim 7; or
- (b) a structure as set forth in claims 8 and 20.

Applicants traverse on the ground that the number of species is not unreasonable and that a search of all disclosed species encompassed by generic species SEQ ID NO: 17, which Applicants elected in their Response filed October 21, 2002, would not require an unduly extensive or burdensome search on the part of the Examiner. Applicants submit that, while the listed species are patentably distinct, a thorough search of one species likely will result in art relevant to the examination of other species within the generic species. Specifically, SEQ ID NOS: 1 and 2, CGFECVRQCPERC and CGFELETC, respectively, are species of the genus set forth as SEQ ID NO:17, X1-G-F-E-X2, wherein X1 and X2 each is 1 to 10 independently selected amino acids. For these reasons, a search of the disclosed species encompassed by the

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generic species of SEQ ID NO: 17 would not necessitate an unduly extensive or burdensome search by the Examiner.

Nevertheless, in order to be responsive to the requirement as required under 35 U.S.C. § 121, Applicants elect, with traverse, an MDP-binding homing molecule comprising SEQ ID NO: 1, as set forth in claim 7.

**CONCLUSION**

Applicants appreciate the Examiner's reconsideration of the Restriction and Election of Species Requirements. The Examiner is invited to call the undersigned attorney or Cathryn Campbell if there are any questions regarding this application.

Respectfully submitted,

April 3, 2003  
Date

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AMENDMENT TRANSMITTAL LETTER			DOCKET NUMBER: 066654-585 (P-LJ 4377)	
SERIAL NO: 09/676,475	FILING DATE: September 29, 2000	EXAMINER: M. Moran	GROUP ART UNIT: 1631	
INVENTION: METHODS OF IDENTIFYING LUNG HOMING MOLECULES USING MEMBRANE DIPEPTIDES				

TO COMMISSIONER FOR PATENTS

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Transmitted herewith is a Response to the Office Action mailed February 11, 2003, in the above-identified application.

- ☒ Small Entity status of this application has been established under 37 CFR 1.27.
- ☐ Petition for Extension of Time is enclosed (in duplicate).
- ☐ Terminal Disclaimer with fee under 37 C.F.R. 1.20(d) is enclosed.
- ☒ No additional claims fee is required.
- ☐ An additional claims fee is required and has been calculated as shown below:

CLAIMS AS AMENDED

	NUMBER AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		NUMBER OF EXTRA CLAIMS PRESENTED		RATE			FEE	
							SMALL ENTITY	OTHER ENTITY		SMALL ENTITY	OTHER ENTITY
TOTAL CLAIMS	26	-	26	-	0	x	\$9	\$18	=	\$0.00	\$
INDEPENDENT CLAIMS	1	-	3	-	0	x	\$42	\$84	=	\$0.00	\$
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM			YES		XX NO		\$140	\$280	=	\$0.00	\$
							TOTAL ADDITIONAL FEE			\$0.00	\$

\* If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 20, write "20" in this space.

\*\* If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 3, write "3" in this space.

\*\*\* If the difference between the "NUMBER AFTER AMENDMENT" and the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 0, write "0" in the space.

☐ Please charge my Deposit Account No. 03-0370 the amount of \$\_\_\_\_\_. A duplicate copy of this sheet is enclosed.

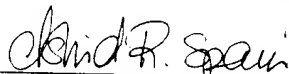
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\_\_\_ A check in the amount of \$ \_\_\_\_\_ is enclosed, \$ \_\_\_\_\_ of which covers the fee for a \_\_\_\_\_-month extension of time.

X The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 502624. A duplicate copy of this sheet is enclosed.

X The Commissioner is hereby authorized to charge to Deposit Account No. 502624 any fees under 37 CFR 1.17 which may be required under 37 CFR 1.136(a)(3) for an extension of time in any concurrent or future reply requiring a petition for extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



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